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cont
79. (New) The device of claim 1, 52, 53, 69 or 70, further including means for direct connection to a computer for downloading or uploading data between the computer and the device.
80. (New) The device of claim 1, 52, 69 or 70 further comprising, a remote microphone and earpiece speaker operably connected to said cellphone and memory.

### REMARKS

The Office Action mailed February 5, 2003 (the "Office Action") recites the guidelines for the arrangement of a patent specification and rejects all of the original claims under 35 U.S.C. 103(a) as being unpatentably obvious over a combination of references, primarily applying in each rejection the combination of Kikinis (6,243,596) in view of Erkkila, et al. (6,219,560). Reconsideration of those actions set forth in the Office Action is respectfully requested in view of the reasons and arguments set forth below.

It is noted that by the foregoing amendment to the specification, Applicant has identified U.S. Patent No. 6,278,884 that issued June 5, 2001 based on the parent application Serial No. 08/846,108 to which this is a Continuation-in-Part. That patent is incorporated by reference herein by that amendment whereby its disclosure may support some of the claims herein, MPEP 608.01(p), and 2163.07(b). Furthermore, as discussed more fully below in connection with the cited references, the filing date of April 25, 1997 of that parent application forms a priority for overcoming alleged prior art cited against this application based on the subject matter disclosed in that parent application.

### **Arrangement of the Specification**

The Office Action sets forth on page 2 the preferred layout of the specification of a utility patent application, including the titles of sections, as provided in 37 C.F.R. 1.77(b). However, as the Examiner is well aware and the Office Action states, that preferred layout and those preferred titles are not required but only that "the specification should include the following sections in order", 37 C.F.R. 1.77(b). While the subject application is arranged in that preferred order, Applicant prefers not to include the section titles, except for the "Abstract of the Disclosure".

### **Alleged Prior Art Applied in Claim Rejections**

The Office Action applies Kikinis (6,243,596) in view of Erkkila, et al. (6,219,560) in each of the claim rejections under 35 U.S.C. Section 103(a). Kikinis '596 was filed February 3, 1998 as a Continuation-in-Part of Serial No. 08/791,249, filed January 30, 1997, which was a Continuation-in-Part of Serial No. 08/629,475 filed April 10, 1996 that issued as Patent No. 5,727,159. Since each succeeding application was a Continuation-in-Part, by definition it would have added disclosure not found in the preceding application. The grandparent application resulting in Kikinis 5,727,159 contains only Figs. 1-6, substantially less disclosure than Kikinis '596, and even has a title that is unrelated to "... A Cellular Phone with a Capability to Access and Browse the Internet" contained in the title of Kikinis '596. Insofar as counsel for Applicant can determine, the intermediate Kikinis application Serial No. 08/791,249 did not issue as a patent and its content is unknown and not of record herein. Because Kikinis '596 that was applied in the rejections of Applicant's

claim was filed February 3, 1998, subsequent to the filing date of April 25, 1997 of Applicant's parent application that resulted in U.S. Patent 6,278,884 (copy of which is enclosed for the Examiner's convenient reference, although obviously it is not prior art), Kikinis '596 is not prior art under 35 U.S.C. Section 102 with respect to anything disclosed in Applicant's Patent No. 6,278,884 that now is incorporated in the subject application by reference.

The Office Action, pages 3 and 4, recites numerous elements and features of Kikinis '596 in support of the claim rejections that are disclosed in Applicant's parent Patent No. 6,278,884 and not in Kikinis '159, whereby those elements and features are not prior art, as follows:

- (a) "Mobile entertainment and communication device",
- (b) "a housing (100) of a palm-held size",
- (c) "a cell-phone provided in the housing",
- (d) "a memory provided in the housing",
- (e) "a microprocessor provided in the housing",
- (f) "the microprocessor having means for selectively downloading data into memory",
- (g) "modem",
- (h) "a battery mounted in the housing", and
- (i) "random access memory".

Thus, a substantial proportion of the elements and features of Kikinis '596 relied upon for the claim rejections in the Office Action are not prior art because of Applicant's parent application (now U.S. Patent 6,278,884) that discloses those elements. Thus, all of

the claim rejections in the Office Action are unsupported for at least this reason and therefore must be withdrawn.

Further, the Office Action relies on Erkkila as a secondary reference in each of the claim rejections under 35 U.S.C. 103(a) but Erkkila was filed in the United States on October 1, 1997, which is subsequent to the April 25, 1997 filing date of Applicant's parent application that resulted in Applicant's U.S. Patent 6,278,884. Again, as with Kikinis '596, Erkkila is not prior art as to anything disclosed in Applicant's parent application that resulted in Patent No. 6,278,884. Specifically, the Office Action recites the following elements and features of Erkkila that are disclosed in Applicant's 6,278,884 patent and therefore not prior art:

- (a) "a modular mobile communication system",
- (b) "device to provide ... visual communication",
- (c) "store pictures", and
- (d) "providing optional functionalities such [as] downloading images and sounds into the communication device".

Thus, Erkkila is not prior art against the subject application for several of the elements and features disclosed and claimed in this application and which are essential to applying Erkkila as a secondary reference under 35 U.S.C. 103(a). This is a separate and additional reason why the claim rejections set forth in the Office Action must be withdrawn.

It should be noted that although it has not been applied in a claim rejection, the cited Farris, et al. (6,167,253) patent was filed December 24, 1997 as a Continuation-in-Part and therefore has the same defects in qualifying as a prior art reference as the Kikinis '596

patent. Similarly, Boys (6,314,094) was filed October 29, 1998 and, although it is not applied in rejecting any of the claims or even listed in PTO-892, it is mentioned in the Conclusion of the Office Action but it would not be prior art as to anything disclosed in Applicant's parent Patent 6,278,884.

**Obviousness Rejection Under 35 U.S.C. 103(a)**

Each of the original independent claims (Claims 1, 21 and 51) and many of the original dependent claims are rejected in the Office Action under 35 U.S.C. 103(a) as being unpatentably obvious over Kikinis in view of Erkkila without reliance upon any other secondary references. Even if Kikinis and/or Erkkila did qualify as prior art references under 35 U.S.C. 102, which Applicant does not concede for the reasons set forth above, it is respectfully submitted that the obviousness rejection based on those two references is inadequate. It is not sufficient to merely find each element of a claim in one of the plural references applied in the rejection. For asserting obviousness under 35 U.S.C. Section 103(a), it is the obligation of the Examiner to establish a *prima facie* case of obviousness that requires three basic criteria and, in particular, the Examiner has the burden of establishing that the prior art has some suggestion of the desirability of doing what the inventor has done and claimed. Specifically, these requirements for an obviousness rejection are set forth in Section 706.02(j) of the Manual of Patent Examining Procedure (MPEP) as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success.

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 – § 2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex Parte Clapp*, 277 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP Section 2144 – Section 2144.09 for examples of reasoning supporting obviousness rejections."

Establishing the motivation for combining the references is further considered in the PATENTABILITY Chapter of the MPEP by reference to case decisions in Section 2143.01 "THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION", as follows:

There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons or ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

Still further in the MPEP the issue of the differences between the prior art and the claimed invention as it relates to obviousness is considered in Section 2141.02 in the subsection "THE CLAIMED INVENTION AS A WHOLE MUST BE CONSIDERED", as follows:

In determining the differences between the prior art and the claims, the question under 35 U.S.C. §103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983).

Here, there is no motivation for combining Kikinis and Erkkila to achieve the "CLAIMED INVENTION AS A WHOLE", as set forth in the original independent claims 1, 21 and 51. Kikinis discloses in the embodiment of Figs. 9-12 applied by the Office Action (see the Section "Cell-Phone Internet Browser", column 14, line 63 to column 19, line 29), an adapter 100 to replace the cell-phone battery pack. The adapter 100 adds elements and functions that are not included in the cell-phone, such as a viewing lens 103 for viewing an internal display 202 and a microphone 203, while retaining the normal functions of the cell-phone 310. In a similar concept, Erkkila teaches the addition to a mobile telephone of an expansion card 10 that adds one or more selected functions to the mobile telephone, such as a camera or an optical unit 65 and CCD 66, a fax capability (column 4, line 3), an extra microphone (column 4, line 18), a security device (column 4, line 28), and a "wish list" of an additional loud-speaker, a mouse, digitizing tablet, bar code reader or external display (column 4, lines 44-48). In other words, both Kikinis and Erkkila disclose "adapters" for cell-phones that add functions that are not performed by the basic cell-phone and therefore there is no motivation to modify the Kikinis adapter with the Erkkila adapter but rather the motivation to one skilled in the art of cell-phones would be to use either the teachings of Kikinis or the teachings of Erkkila to create an adapter, but not both. Even if it is remotely possible that there may be motivation to use the teachings of both Kikinis and Erkkila,

which Applicant does not concede, the only obvious combination would be for both to be used as separate adapters to a cell-phone, not to use the Erkkila device as an adapter on the Kikinis adapter.

Also, it should be noted that Erkkila teaches an "expansion card" that expands the functions of the mobile phone by adding fax capability, a microphone, a security device, a loud speaker, a mouse, a digitizing tablet, a bar code reader or an external display, as identified above, rather than Applicant's claimed "replaceable memory card". Each "expansion card" requires a control program and other elements, such as the camera of Figs. 1-3. Erkkila does not teach a "replaceable memory card" or an enclosed socket therefore, as taught and claimed by Applicant, but rather Erkkila teaches away from Applicant's memory card enhancement of the existing functions of the cell-phone and integral camera.

Thus, even if Kikinis and Erkkila are assumed to constitute prior art for everything set forth therein, which Applicant does not concede because of Applicant's priority filing date, there is no suggestion or motivation to make the alleged combination by reason of (1) the nature of the problem to be solved, (2) the teachings of the prior art, or (3) the knowledge of persons of ordinary skill in the art as required by In re Rouffet, supra, MPEP § 2143.01. Further, the resultant combination of Kikinis in view of Erkkila that would be obvious, if any, to one skilled in the art would be two separate adapters for a cell-phone rather than Applicant's integrated "mobile entertainment and communication device".



**Supplemental Secondary References Applied for Obviousness**

The Office Action applies five other supplemental secondary references to the combination of Kikinis in view of Erkkila in rejecting the balance of the original dependent claims. The disclosures of some of those supplemental secondary references do not support the grounds for which they are applied in the rejection and/or there is no motivation to make the combination or modification suggested by the Office Action as required for an obviousness rejection, as discussed above.

Schwartz discloses a compartment with a door 105 for installing a card, not a slot as asserted by the Office Action and disclosed and claimed by Applicant. Further, the Schwartz arrangement is for accepting a Subscriber Identification Card or chip, which are of different sizes, not a replaceable memory card for increasing the memory of the cell-phone. Although column 2, line 35 mentions "memory cards or the like", there is no description as to what function such a memory card would perform, although perhaps the only obvious type in the Schwartz cellphone would be to provide memory for names, telephone numbers, addresses, etc., not for recording from the internet.

Purdy discloses a "Personal Data Collection and Reporting System" that has as its only mode of operation to transmit images and sounds from the personal data collection unit 10 to a remote location. Purdy does not function as a telephone and there would be no motivation to combine or modify Kikinis and Erkkila by the teachings of Purdy.

Shamosh discloses a security protection system for buildings, vehicles and airplanes and therefore is not a hand-held device as required by each of Applicant's claims. There

would be no motivation to modify the cell-phones of Kikinis or Erkkila, or even the mobile device of Purdy, by the teachings of Shamosh from the non-analogous art of security systems for structures.

Simkin is directed to a "Global Positioning System Personal Alarm", as the title suggest, rather than a cell-phone as claimed by Applicant.

### **New Claims**

By the foregoing amendment, Applicant has added new claims 52-80 that include independent claims 52, 53, 69, 70 and 71 that are couched in somewhat different terminology and scope than original independent claims 1, 21 and 51. It is believed that each of the new independent claims distinguish over the prior art and therefore a favorable action on the merits is respectfully requested. Specifically, for example, claim 52 requires a cellphone device that includes a microphone and memory for capturing and storing sounds that can then be transmitted wirelessly. Claim 53 is like claim 52 but also adds voice controlled dialing and a remote microphone and earpiece speaker. Claim 69 adds the camera and the function of transmitting captured or stored images and sound. Claim 70 specifically defines the images and sounds being captured and transmitted as "continuing real time [images and sound] over a period of time", i.e. not simply a still picture image or single sound, although the other claims also include such continuing images and sounds. Claim 71 is similar to claim 70 but also adds voice controlled dialing and a remote microphone and earpiece speaker. Each dependant claim adds a limitation and therefore is allowable for least the same reasons the claim from which it depends is allowable.

**Supplemental Information Disclosure Statement**

A Supplemental Information Disclosure Statement is being filed concurrently herewith to bring to the attention of the Examiner all of the references cited during the prosecution of Applicant's parent application of which this is a CIP that resulted in U.S. Patent No. 6,278,884 that is now incorporated by reference. Care has been taken to only add the references by this Supplemental Information Disclosure Statement that are not already of record in this CIP application by reason of Applicant's original Information Disclosure Statement with a PTO-1449 form and the two lists of references cited by the Examiner on PTO-892 forms.

Also added by this Supplemental Information Disclosure Statement is Wilska U.S. Patent No. 6,427,078 that was originally filed May 18, 1995 although it didn't issue until July 2002 and only recently came to Applicant's attention. Although Wilska is directed to a notebook computer of a size larger than a cellphone, it discloses the inclusion of a mobile phone and camera as part of the device but fails to disclose all of the functions of Applicant's device, as claimed.

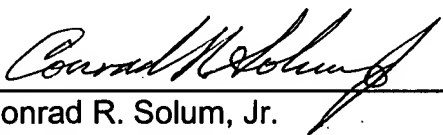
**Summary and Conclusions**

For the reasons set forth above, it is believed that all of the pending claims 1-80 are allowable over the references applied in the Office Action and therefore, unless new grounds for rejection are found, it is respectfully requested that all of the claims be allowed.

Respectfully submitted,

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Dated: 4/23/03

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MARKED-UP VERSION OF SPECIFICATION  
Serial No. 09/531,356  
Ki Il Kim

Page 1, line 2 (immediately following the Title), delete the paragraph and replace that paragraph with the following paragraph:

-- This is a Continuation-In-Part of application Serial No. 08/846,108, filed April 25, 1997, now U.S. Patent No. 6,278,884, which is incorporated in this application in full by this reference. --